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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,681	03/16/2004	Hideo Ando	249726US2SDIV	1656

22850 7590 05/17/2006

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EXAMINER

NGUYEN, HUY THANH

ART UNIT PAPER NUMBER

2621

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/800,681

Applicant(s)

ANDO ET AL.

Examiner

HUY T. NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/12/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 20- 24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,560,405. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 20-24 of the present application and claims 1-4 of U.S. Patent No. 6,560,405. is that claims 1-4 of U.S. Patent No. 6,560,405 additionally recite that the still video object further comprising subpicture packs that is not found in claims 20-24 of the present application. However, it is noted that elimination apart is obvious to one of ordinary skill in the art. See Elimination of

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an element and its function---In re Karlson, 153 USPQ 184 (CCPA 1963).Therefore, it would have been obvious to one of ordinary skill in the art to modify claims 1-4 of U.S. Patent No. 6,560,405 by eliminating subpicture packs from the still video object recited in claims 1-4 of U.S. Patent No. 6,560,405 to produce claims 20-24 of the present application .

3. Claims 20- 24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 7,043,140. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 20-24 of the present application and claims 1-4 of U.S. Patent No. 7043140 is that claims 1-4 of U.S. Patent No. 7,043,140 additionally recite that the still video object group information further comprising a start address of a corresponding still picture video object group that is not found in claims 20-24 of the present application . However , it is noted that elimination apart is obvious to one of ordinary skill in the art . See Elimination of an element and its function---In re Karlson, 153 USPQ 184 (CCPA 1963).Therefore, it would have been obvious to one of ordinary skill in the art to modify claims 1-4 of U.S. Patent No. 7,043,140 by eliminating start address of a corresponding still picture group video object recited in claims 1-4 of U.S. Patent No. 7,043,140 and to produce claims 20-24 of the present application .

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4. Claims 20- 24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,763,180. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 20-24 of the present application and claims 1-4 of U.S. Patent No. 6,763,180 is that claims 1-4 of U.S. Patent No. 6,763,180 additionally recite that the still video object group information further comprising a search pointer comprising a start address of a corresponding still picture video object group information that is not found in claims 20-24 of the present application. However, it is noted that elimination apart is obvious to one of ordinary skill in the art. See Elimination of an element and its function---In re Karlson, 153 USPQ 184 (CCPA 1963). Therefore, it would have been obvious to one of ordinary skill in the art to modify claims 1-4 of U.S. Patent No. 6,763,180 by eliminating the search recited in claims 1-4 of U.S. Patent No. 6,763,180 and to produce claims 20-24 of the present application.

5. Claims 20- 24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,360,056. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 20-24 of the present application and claims 1- 5 of U.S. Patent No. 6,360,056 is that claims 1- 5 of U.S. Patent No. 6,360,056 additionally recite that the still video object group information further comprising a user defined program chain information that is not found in claims 20-

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24 of the present application . However , it is noted that elimination apart is obvious to one of ordinary skill in the art . See Elimination of an element and its function---In re Karlson, 153 USPQ 184 (CCPA 1963). Therefore, it would have been obvious to one of ordinary skill in the art to modify claims 1- 5 of U.S. Patent No. 6,360,056 by eliminating the user defined program chain information recited in claims 1- 5 of U.S. Patent No. 6,360,056 and to produce claims 20-24 of the present application .

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N


HUY T. NGUYEN
PRIMARY EXAMINER